

REMARKS

In response to the restriction requirement dated October 27, 2004, claims 18-21 and 25 are provisionally elected. This election is provisional because the restriction is improper; reconsideration is requested.

The requirement for restriction is believed to be improper because the examiner has failed to establish that distinct inventions are claimed. For example, claims 18-21 are method claims and claims 22-24 are similar in that they are directed toward software. The examiner characterizes the two groups of claims as distinct inventions that are related by being a process of making and a product made. *See* paper dated 10/27/2004, pages 2-3.

Independent claim 18 calls for detecting the on/off state of at least one light associated with a microscope, analyzing an image captured by an imaging unit associated with said microscope, and setting the color balance of said imaging unit at least in part based on an analysis of said image, the on/off state of said light, and the nature of said light. In comparison, independent claim 22 calls for... a *processor-based system* to detect the on/off state of at least one light associated with a microscope, analyze an image captured by an imaging unit associated with said microscope, and set the color balance of said imaging unit at least in part based on an analysis of said image recorded by an imaging unit, the on/off state of said light, and the nature of said light. Thus, the method of claim 18 and the instructions of claim 22 are related, but not in the manner asserted by the examiner.

A fair reading of M.P.E.P. § 806.05(f), which is cited in the Office action, is that the product made by a claimed process may, under certain circumstances, be distinct from the process of making the product. *See* M.P.E.P. § 806.05(f) (“a process of *making* and a product *made by the process* can be shown to be distinct inventions if...”) (emphasis added). In other words, the product is distinct from the process of making that product if certain conditions are met. But, nowhere in the Office action is it shown where a product is distinct from the process of making that particular product.

The sole basis set forth in the Office action for alleged distinctiveness is that the group I invention can be executed differently than the group II invention. For example, the examiner asserts that the method as defined in the invention I does not need a processor-based system as defined in invention II; the operation of the microscope of invention I can be executed differently than in invention II. But, pursuant to M.P.E.P. § 806.05(f) distinctiveness is not based on execution of a method; rather, to be distinct, "the process as claimed is not an obvious process of *making the product* and the process as claimed can be used to *make* other and different products." *Id.* (Emphasis added).

According to this standard, *use* of a processor-based system does not give rise to distinctiveness. That is, a processor-based system is not *made* by any claimed process. But, the relationship for distinctiveness is based on a product -- the distinct product -- that is *made* by the claimed process. Quite simply a process is not claimed that makes a product in which the product is distinct from the process of making the product. As such, the restriction requirement is respectfully traversed.

The application is believed to be in condition for allowance. The examiner's prompt action in accordance therewith is respectfully requested.

Respectfully submitted,

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